

REMARKS

STATUS OF THE CLAIMS

Claims 38-106 are pending. Claims 59, 61-68, 70-77, 80-82, and 85-87 were withdrawn from consideration by the Examiner as being “directed to non-elected species.” Office Action, page 2. No claim was amended herein.

DOUBLE PATENTING REJECTION

The Examiner rejected claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 under the judicially created doctrine of obviousness-type double patenting over claims 1-41 of U.S. Patent No. 6,346,234 to Rollat et al. (“Rollat”), in view of EP 0 551 749 to Lee et al. (“Lee”). Specifically, the Examiner pointed out that while Rollat only claims a “tacky polymer” composition, Lee teaches a water-soluble amphoteric polymer. See Office Action, pages 2 and 3. Therefore, according to the Examiner, a person of ordinary skill in the art would have been motivated to combine these two references to arrive at a polymer composition mixture (i.e., a tacky polymer and an amphoteric fixing polymer) as recited in the present claims. Applicants respectfully disagree.

First, Applicants respectfully submit that the Examiner has mischaracterized the polymer composition claimed in Rollat because Rollat does not claim a “tacky polymer” as contended by the Examiner. Rather, Rollat claims a hair styling composition that comprises “at least one polymer selected from anionic, cationic, amphoteric and nonionic **fixative** polymers.” See, for example, col. 8, lines 30-32. (Emphasis added). The Examiner had apparently mistaken the **fixative** polymer claimed in Rollat for a

tacky polymer. As a result, combining Rollat and Lee will not meet all aspects of the claimed invention because neither reference discloses at least one tacky polymer having a glass transition temperature (Tg) of less than 20°C and at least one fixing polymer having a glass transition temperature (Tg) greater than 15°C as recited, for example, in claim 38 of the present application.

Moreover, no motivation exists for the combination and modification that the Examiner suggests. "When considering whether the invention defined in a claim of an application is an obvious variation of the invention defined in the claim of a patent, the disclosure of the patent may not be used as prior art." M.P.E.P. §804(II)(B)(1). One significant difference between a double patenting rejection and a rejection based on prior art is that "a double patenting rejection must rely on a comparison with the claims in [the prior art] while an obviousness rejection based on the same [prior art] relies on a comparison of what is disclosed (whether or not claimed) in the same [prior art]. M.P.E.P. §804(III).

In the present case, the Examiner has pointed to no teaching in the claims of either Rollat or Lee, and Applicants believe that no such teaching exists, that would have led one of ordinary skill in the art to make the combination suggested by the Examiner. Instead, the Examiner attempted to rely upon the specifications of the prior art in an attempt locate the motivation needed to piece together the combination suggested by the Examiner. However, such reliance is misplaced in a double patenting rejection.

For these reasons, Applicants respectfully submit that the Examiner's obviousness-type double patenting rejection is improper, and request that this rejection be withdrawn.

REJECTIONS UNDER 35 U.S.C. § 112, FIRST PARAGRAPH

The Examiner rejected claims 38-43, 45-50, 69, 78, 79, 83, 84, and 88-106 under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The Examiner alleges that the polymer composition in the claims:

are solely defined by physical properties [such as] 'tacky'; Tg, F_{max}, or E_{s(M/V)}. etc. However, the specification provide [sic] no written description as to what the structural characteristics of a polymer would be required to meet all the functional limitations herein. In view of the fact of lacking working examples, guidance, and direction, one of ordinary skill in the art would have reasonable doubt that applicants, at the time the application was filed, had actually [sic] possession of such polymers other than the particular commercially available polymers herein employed.

Office Action, pages 3 and 4. Applicants respectfully disagree.

To satisfy the written description requirement, a patent specification must describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention. M.P.E.P. §2163. Notably, there is a strong presumption that an adequate written description of the claimed invention is present when the application is filed. M.P.E.P. § 2163(I)(A). In order to show that the specification fails to meet the written description requirement of §112, first paragraph, the Examiner must present evidence or specific

reasoning to support the Examiner's challenge. Specifically, as set forth in the U.S. Patent & Trademark Office's ("PTO") examination guidelines:

[I]f the examiner determines that the application does not comply with the written description requirement, the examiner has the **initial burden**, after a thorough reading and evaluation of the content of the application, **of presenting evidence or reasons** why a person skilled in the art would not recognize that the written description of the invention provides support for the claims

Written Description Guidelines, page 4, www.uspto.gov/web/menu/written.pdf
(emphasis added).

Applicants respectfully submit that the Examiner has not met this burden in the present rejection. Instead, the Examiner has merely made an unsupported and factually incorrect allegation that the specification lacks "working examples, guidance, and direction" regarding the claimed polymers. This allegation ignores the teachings of the present specification that exists regarding the claimed polymers. For example, pages 4 through 6 of the specification set forth guidance regarding the glass transition temperature (T_g), peeling force (F_{max}) and separation energy $E_{s(MW)}$ that a tacky polymer according to the present invention may have. Pages 6 through 12 then provide examples of such tacky polymers. Examples illustrating the use of such polymers are set forth on pages 17 through 22 of the specification.

Applicants therefore believe the Examiner is factually incorrect because the aforementioned portions of the specification provide "working examples, guidance, and direction" regarding the claimed polymers. Thus, as specified in the PTO's Written Description guidelines, the Examiner has not provided evidence or reasons why a

person skilled in the art would not recognize that the written description of the invention provides support for the claims.

Moreover, the Examiner has ignored the fact that literal support exists for the invention as claimed. The Examiner therefore has not provided evidence or reasons why the claimed invention is not supported by the specification since literal support is in fact present.

For these reasons, Applicants respectfully submit that the Examiner's rejection under 35 U.S.C. § 112, first paragraph, is improper, and request that this rejection be withdrawn.

REJECTION UNDER §103(a)

The Examiner rejected the claims 38-58, 60, 69, 78, 79, 83, 84, and 88-106 as being unpatentable under 35 U.S.C. §103(a) over Lee in view of WO 95/18191 to Miller et al. ("Miller"). The Examiner acknowledges that Lee does not teach branched sulfonic polyester having a glass transition temperature ("Tg") of less than 20°C, as presently claimed. See Office Action, page 5.

The Examiner alleges, however, that this deficiency could be cured by Miller, because Miller discloses an adhesive composition that comprises a branched polyester with a low Tg. *Id.* According to the Examiner, it would have been obvious to "modify Lee's composition by using the branched sulfonic polyester [of Miller] as the water-dispersible resin because the branched sulfonic polyester will not become brittle or [lose] its property at low temperature." *Id.* Applicants respectfully disagree.

To establish a prima facie case of obviousness under 35 U.S.C. § 103, the Examiner bears the burden of establishing each of three requirements. These

requirements include that the Examiner show that some suggestion or motivation exists, either in the references themselves, or in the knowledge generally available to one of ordinary skill in the art, to modify the references to achieve the presently claimed invention, and that the Examiner establish a reasonable expectation of success for the proposed combination and modification. See M.P.E.P. §§ 2143.01 and 2143.02. Each of these requirements must “be found in the prior art, and not be based on applicant’s disclosure.” M.P.E.P. §2143.

The Federal Circuit reaffirmed the Examiner’s high burden to establish a *prima facie* case of obviousness and emphasized the requirement for specificity. In *In re Sang-Su Lee*, the Federal Circuit held that “[t]he factual inquiry whether to combine references must be thorough and searching. It must be based on objective evidence of record. . . and cannot be dispensed with.” *In re Sang-Su Lee*, 277 F.3d 1338, 1433 (Fed. Cir. 2002). Further, the Federal Circuit explained that

[t]he need for specificity pervades this authority... the examiner can satisfy the burden of showing obviousness of the combination only by showing some objective teaching in the prior art or that knowledge generally available to one of ordinary skill in the art would lead that individual to combine the relevant teachings of the references.

Id. (internal citations and quotation omitted) (emphasis added). Importantly, the mere fact that the references **can** be combined does not render the resultant combination obvious **unless** the prior art also suggests the **desirability** of the combination. See M.P.E.P. §2143.01 (emphasis added).

In the present case, Applicants respectfully submit that this requisite objective teaching that would have led to the combination of Lee and Miller suggested by the

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Examiner has not been demonstrated by the Examiner. The Examiner offered no basis, nor does any exist, why one of ordinary skill in the art would have chosen to modify the composition of Lee by selecting the water-dispersible resin of Miller from among all the other water-dispersible resins known in the art. Further, the Examiner offered no basis why one of ordinary skill in the art would desire to modify the composition of Lee in the first place.

Absent the requisite objective teaching that would have led one of ordinary skill in the art to make the combination suggested by the Examiner, Applicants submit that a *prima facie* case of obviousness has not been established by the Examiner. Accordingly, Applicants request that the rejection under §103 be withdrawn.

CONCLUSION

In view of the foregoing remarks, Applicants respectfully request the reconsideration of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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